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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/436,598	11/09/99	LENNIGER	A GR-97-P-1593
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EXAMINER

GRAYBILL, D

ART UNIT

PAPER NUMBER

2814

DATE MAILED:

08/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/436,598

Applicant(s)

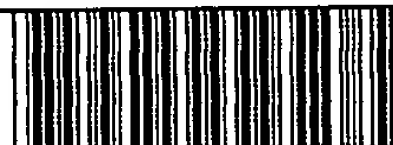
Lenniger et al.

Examiner

David E. Graybill

Group Art Unit

2814



☒ Responsive to communication(s) filed on 9 Nov 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-7 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-7 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Application/Control Number: 09436598

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The information disclosure statement filed 11-9-99 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but JP7153906 has not been considered.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 and 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by applicant's admitted prior art.

At page 1, line 10 to page 2, line 13; and page 6, line 11 to page 7, line 14, applicant admits as conventional a product comprising a substrate 4 disposed in a plastic housing 2 defining a housing base of the housing, the substrate containing a ceramic plate 5 having a top side and a bottom side with a top metallization layer 6 disposed on the top side and a bottom metallization layer 7 disposed on the bottom side, the top metallization layer facing an interior of the housing being patterned in order to form interconnects and equipped for and receiving semiconductor components 10; connecting elements 8 interconnecting the components; and terminal elements 11 for providing external terminals in housing element openings, wherein the elements run approximately parallel to the housing base in the interior of the housing, the housing includes a

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frame 9 and a cover, the elements are disposed in the frame, and the substrate is covered with a potting compound (illustrated in FIG 1).

Although applicant does not appear to explicitly admit as prior art the process limitation “terminals press-fitted into housing element openings,” the product of applicant’s admitted prior art inherently possesses the characteristics imparted by the limitation.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant’s admitted prior art as applied to claims 1 and 3-6, and further in combination with Leukel (FR2535898).

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Although applicant admits as prior art a product wherein the housing has an inner side, applicant does not appear to explicitly admit as prior art a product wherein the elements have lugs which bear on the inner side for fixing the elements in position, and the compound is formed of a soft potting layer and a hard potting layer disposed on the soft layer. Nonetheless, at page 6, lines 11-21, Leukel teaches a product wherein elements 10, 12 have lugs which bear on the inner side of housing 16 for fixing the elements in position, and the compound is formed of a soft potting layer 15 and a hard potting layer 16 disposed on the soft layer. Moreover, it would have been obvious to combine the product of Leukel with the product of applicant's admitted prior art because it would increase package reliability.

The prior art made of record and not applied to the rejection is considered pertinent to applicant's disclosure. It is cited primarily to show products similar to the product of the instant invention.

Any telephone inquiry of a general nature or relating to the status (MPEP 203.08) of this application or proceeding should be directed to the group receptionist at (703) 308-1782.

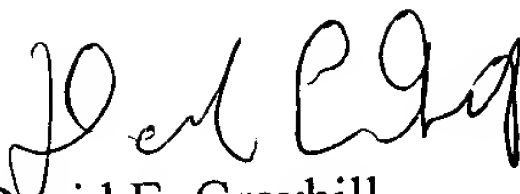
Any telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (703) 308-2947. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m..

The fax phone number for group 2800 is (703)305-3431.

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David E. Graybill
Primary Examiner
Art Unit 2814

D.G.